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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,048	04/24/2006	Stefan Dengler	PNL21523	2323
77407 7590 07/23/2008 Novak Druce & Quigg LLP 1300 I Street NW Suite 1000 West Tower Washington, DC 20005				
EXAMINER				
CHANG, CHING				
ART UNIT		PAPER NUMBER		
3748				
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07/23/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/577,048

**Applicant(s)**

DENGLER, STEFAN

**Examiner**

CHING CHANG

**Art Unit**

3748

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/5/08 has been entered. Claims 1-15 are cancelled, and new claims 16-23 are added as requested.

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1(a). Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of copending US Patent Application No. 10/549,612.

Although the conflicting claims are not identical, they are not patentably distinct from each other, because the scope of claim 1 of the instant application is broader than that of claim 7 of the copending US Patent Application '612.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

1(b). Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of copending US Patent Application No. 10/549,612.

Although the conflicting claims are not identical, they are not patentably distinct from each other, because the scope of claim 1 of the instant application is broader than that of claim 10 of the copending US Patent Application '612.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

More specifically, both "said first cam element" and "said second cam element" include the same "at least first and second cam tracks", thus render the claimed subject matter in claim 17 inoperative.

4. Claims 16-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More specifically, "means cooperable with a selectively operable member for axially displacing said shaft" in claim 16, "a helically configured cam surface" and "a member" in claim 22, and "a pair of helically configured cam surfaces provided in said shaft, inclined in opposed directions, cooperable with members received therein." in claim 23 are new matter.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. ***Claims 16-23 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Vignery (BE ' 654, recited in WO 2005/040562 A1 search report).***

Vignery disclose a camshaft (3) of an internal combustion engine having at least one cylinder and two fuel inlet valves (10) for said cylinder, comprising a shaft ,having a first, rigidly mounted cam element (7, 5) provided with a first configuration, cooperable with one of said valves, a second, rigidly mounted cam element (6, 4) provided with a second configuration different than said first configuration, cooperable with the other of said valves, and means (See Fig. 2) cooperable with a selectively operable member (one of 14, 15, 16, or of 17, 18, 19, or of 31, 32, 33, or of 34, 35, 36) for axially displacing said shaft; wherein said first cam element, includes at least first and second cam tracks, and said second cam element includes at least third and fourth cam tracks; wherein one of said cam tracks is provided with a configuration different from at least one of the other of said cam tracks; wherein at least one of cam tracks includes a lobe; wherein said lobe has a radius which differs from at least one of another of the lobes of said cam tracks; wherein said lobe is angularly displaced relative to at least one of another of the lobes of said cam tracks; wherein said axially displacing means

comprises, a pair of helically configured cam surfaces provided on said shaft, inclined in opposed, directions, cooperable with members received therein.

8. ***Claims 16-23 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Phillips (US Patent 5,129,407).***

Phillips disclose a camshaft (10) of an internal combustion engine having at least one cylinder and two fuel inlet valves (20) for said cylinder, comprising a shaft ,having a first, rigidly mounted cam element (one of 22, 24, 26, 28) provided with a first configuration, cooperable with one of said valves, a second, rigidly mounted cam element (the other one of 22, 24, 26, 28) provided with a second configuration different than said first configuration, cooperable with the other of said valves, and means (See Fig. 4) cooperable with a selectively operable member (56) for axially displacing said shaft; wherein said first cam element, includes at least first and second cam tracks (one of 22a, 22b, 24a, 24b, 26a, 26b, 28a, 28b), and said second cam element includes at least third and fourth cam tracks (the other one of 22a, 22b, 24a, 24b, 26a, 26b, 28a, 28b); wherein one of said cam tracks is provided with a configuration different from at least one of the other of said cam tracks; wherein at least one of cam tracks includes a lobe; wherein said lobe has a radius which differs from at least one of another of the lobes of said cam tracks; wherein said lobe is angularly displaced relative to at least one of another of the lobes of said cam tracks; wherein said axially displacing means comprises, a pair of helically configured cam surfaces (64, 66) provided on said shaft, inclined in opposed, directions, cooperable with members received therein.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHING CHANG whose telephone number is (571)272-4857. The examiner can normally be reached on M-Th, 7:00 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Denion can be reached on (571)272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ching Chang/  
Primary Examiner, Art Unit 3748